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10/056,120

REMARKS

Reconsideration of the Office Action is respectfully requested.

The present invention is directed to an electric lamp provided with a lamp cap which is suitable for contacting external contacts, and which particularly is capable of contacting external contacts which are at different spacings from the lamp on respective individual carriers. For example, such may be used in automotive as well as other applications where such variable spacings may be encountered and avoids the more expensive approach of having to provide a plurality of different lamp mounting sizes, each to a close tolerance.

In accordance with the invention, the lamp cap has a housing and first and second contact members connected by a spring which renders the second contact part displaceable from the first contact part in a direction transverse to a mounting direction to a degree sufficient to accommodate the different spacings at which the external contact elements are located on respective carriers.

The claims stand rejected as being anticipated by Hall et al. (U.S. 5,250,874), Preziosi et al. (U.S. 3,859,554) or Hancox (U.S. 4,246,632) under 35USC102. The rejections are discussed below.

The gist of the rejections is that because the word "may" was used in claim 1 as presented in the last amendment, the claim connotes a certain measure of likelihood or possibility, and thus is considered to be optional or alternative. Thus, an important feature recited in the body of claim 1, "spring for rendering said second part displaceable ... to a degree sufficient to

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accommodate said different spacings at which said external contact element may be located” was not given any weight in the claim, and the claim was found to be anticipated by the references.

It is respectfully submitted that this position is not well taken.

Thus, the preamble of the claim, relating to the environment of the invention, recited “an external contact element which may be at different spacings from said lamp”, but the body of the claim simply used language which connotes “capability”.

Thus, the preamble means that the contact elements may or may not be at different spacings, while the body of the claim in reciting “to a degree sufficient to accommodate said different spacings at which said external contact element may be located” means that if the contacts are at different spacings, the lamp cap is structured to accommodate such different spacings.

It is well established that claims which connote “capability” are proper, should be given patentable weight, and are not rejectable as being “optional” or “alternative”. For example, an amplifier having a certain circuit may be claimed as “being capable of producing 100 watts”. The claim is not optional just because it always doesn’t produce 100 watts, since this typically would depend on the volume control setting.

Although, claim 1 as presented in the last amendment is believed to be proper and entitled to patentable weight, in order to advance the prosecution of the case, Applicant has herein provided an amended claim 1 which avoids use of the word “may”. In claim 1 as amended, different respective carriers which have contacts at different respective spacings in

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relation to the lamp are defined, hence there is no issue regarding whether or not the claim language is "optional".

It is respectfully requested that claim 1 be entered and that the case be passed to issue. Thus, it is clear that none of the references relate to positioning a lamp on different respective carriers where the contacts are at different spacings. Additionally, as stated in the last Amendment, it would not be obvious to modify the references to include such a structure, since their design requires that the external contacts be at fixed locations, for example see contact 20 of Hancox which can only enter conductor 23 vertically because of the presence of restraining walls 25, or are of the plug-in type such as Hall where the lamp position is fixed and inherently there is no external variable contact spacing. Additionally, in the case of Preziosi, the external contacts 54 if variably spaced, would be so in a direction parallel to, rather than transverse to a mounting direction as required by claim 1.

Thus, it is submitted that the issues necessary to a determination of patentability of amended claim 1 have already been considered by the Examiner. In view of this, a Notice of Allowance of claims 1 to 6 is now respectfully solicited.

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